

IFW

Application No.: 10/725,829

Docket No.: V9661.0043



(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application of: Mee Len Chye *et al.*

Application No.: 10/725,829

Confirmation No.: 7267

Filed: December 1, 2003

Art Unit: 1638

For: GENETICALLY MODIFIED PLANTS  
EXPRESSING PROTEINASE INHIBITORS,  
SAPIN2A OR SAPIN2B, AND METHODS  
OF USE THEREOF FOR THE INHIBITION  
OF TRYPSIN-AND CHYMOTRYPSIN-LIKE  
ACTIVITIES

Examiner: Maria Teresa D.  
Samson

New York, NY  
December 9, 2004

**RESPONSE TO RESTRICTION REQUIREMENT**

MS Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the restriction requirement set forth in the Office Action mailed November 18, 2004, applicant hereby provisionally elects Group I (claims 1-4, 8-47 and 49-58) for continued examination.

The Examiner has required restriction between the following Groups:

I. claims 1-4, 8-47, and 49-58, drawn to isolated proteinase inhibitor II nucleic acid molecule, a method for producing a transformed plant, a transformed

plant, a method for producing a heterologous protein in transgenic plants, and a method of use, classified in class 800, subclass 278;

II. Claims 5-7, drawn to an isolated polypeptide having the amino acid sequence of SEQ ID NO:2, or a fragment of SEQ ID NO:2 or 4 having proteinase inhibitor activity, classified in class 530, subclass 350; and

III. Claim 48, drawn to monoclonal antibody, classified in class 530, subclass 387.1.

The Office Action further states that “[u]pon election of a Group, Applicant is additionally required to select a single nucleotide sequence and an amino acid sequence for said Group, as appropriate. This requirement is not to be construed as a requirement for an election of species, since each nucleotide and amino acid sequence is not a member of single genus of invention, but constitutes an independent and patentably distinct invention (at page 3 of the Office Action).”

Applicants respectfully traverse the requirement for selecting a single nucleotide sequence within the selected group.

According to the MPEP § 803.04, nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another, and, thus, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement under 35 U.S.C. § 121 and 37 C.F.R. § 1.141. However, such restriction requirements have been partially waived *sua sponte* by the Commissioner (see *Examination of Patent Applications Containing Nucleotide Sequences*, 1192 O.G. 68, November 19, 1996) and “it has been determined that normally ten (10) sequences constitute a reasonable number for examination purposes” and “in most cases, up to ten independent and distinct nucleotide sequences, will be examined

in a single application without restriction (the MPEP § 803.04).” The same section of the MPEP further states that “nucleotide sequences encoding the same protein are not considered to be independent and distinct inventions and will continue to be examined together.”

In the present application, the nucleotide sequences recited in the claims of Group I are *only two (2) sequences, i.e.,* SEQ ID NOS:1 and 3, which encode the amino acid sequences of SEQ ID NOS:2 and 4, respectively. Thus, even though each of these nucleotide sequences may be presumed to be an independent and distinct invention and each requires an independent search of the sequence databases, Applicants respectively submit that such searches should not cause undue burdens on the examiner’s part. Furthermore, other nucleotide tide sequences which encode the same amino acid sequences of SEQ ID NOS:2 and 4, respectively, as do SEQ ID NOS:1 and 3, respectively, should be also examined together in the present application, since they are not considered to be independent and distinct inventions.

Accordingly, Applicants respectfully request that the requirement for selecting a single nucleotide sequence within elected Group I be withdrawn.

Nevertheless, in order for the response to the Office Action to be complete, Applicants further provisionally select the examination of the nucleotide sequence of SEQ ID NO:1 as well as the nucleotide sequences encoding the amino acid sequence of SEQ ID NO:2.

Application No.: 10/725,829

Docket No.: V9661.0043

No fees is believed to be due for this submission. Should any fee be required, please charge such fee(s) to Deposit Account No. 50-2215.

Dated: December 9, 2004

Respectfully submitted,

By  \_\_\_\_\_

Charles E. Miller

Registration No.: 24,576

DICKSTEIN SHAPIRO MORIN &  
OSHINSKY LLP

1177 Avenue of the Americas

41st Floor

New York, New York 10036-2714

(212) 835-1400

Attorney for Applicant